

U.S. Application No. 09/914,185
Amendment After Final

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REMARKS

Claims 5 and 7 are pending. Claims 10-13, 15-18, and 20-22 have been cancelled without prejudice or disclaimer.

Claims 5 and 7 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over Shaw (U.S. Patent No. 4,379,822) in view of Sugimoto et al. (U.S. Patent No. 5,981,048).

Applicant agrees that once the Examiner provides evidence that a product of the prior art is the same as the claimed product, the burden shifts to the Applicant to provide evidence establishing a non-obvious distinction between the cited product and the claimed product. Thus, if the Examiner's statement that "the final product of Shaw is a paper layer coated with a dried film in which the coating has the same composition as the claimed invention" (Office Action, page 3, lines 7-9) were true, Applicant would be required to provide evidence.

However, Applicant respectfully presents that the statement of the present Office Action is not an accurate representation of the cited Shaw reference. As stated in the Office Action of September 2, 2004 (incorporated into the present Office Action through the Office Action of April 13, 2005), "Shaw fails to explicitly teach that the conductive polymer composition further comprises a polyethylene wax." Thus, as the Examiner has previously recognized that Shaw fails to teach the inclusion of a polyethylene wax into the composition, and as a result, the final product of Shaw could not have the same composition as the claimed invention as alleged in the Office Action. Accordingly, the burden has not shifted to Applicant to provide evidence to establish a non-obvious distinction.

Moreover, Applicant respectfully presents that it would not have been obvious to one of ordinary skill in the art to modify the composition of Shaw based on the teachings of Sugimoto et al. Sugimoto et al. disclosed an olefin-based extrudable composition to which is added a lubricant, in order to provide lubrication of the polyolefin when melted and subsequently extruded. As the composition of Shaw is neither extruded nor a polyolefin, there is no motivation to add any lubricant, and certainly no motivation to select polyethylene wax from among the laundry list of commercially available lubricants cited in Sugimoto et al., to modify the teachings of Shaw.

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The Examiner clearly fails to establish a *prima facie* case of obviousness which would be reversible error both at the Board of Appeals, as well as the reviewing courts; See, for example, Ex Parte Levengood, 28 USPQ 2d 1300, 1302 (BPAI 1993), stating:

"Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988); In re Newell, 891 F.2d 899, 13 USPQ 2d 1248 (Fed. Cir. 1989). Accordingly, the Examiner can not establish obviousness by locating references which describe various aspects of the patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

Thus, reconsideration is therefore respectfully requested.

Claims 10-13, 15-18 and 20-22 stand rejected under 35 USC § 103(a) as allegedly being unpatentable over combinations of references. However, as these claims have been cancelled through this amendment, Applicant respectfully presents that these rejections are now moot.

For the foregoing reasons, entry of the above-amendments (as significantly reducing the number of issues for appeal), withdrawal of all rejections and passage of the application to issue are respectfully requested.

Respectfully submitted,



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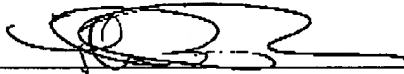
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The undersigned certifies this document has been transmitted by via facsimile to
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